

REMARKS

Currently, claims 1-24, 26-31, 33, and 35-38 remain pending in the present application, including independent claims 1, 24, and 33.

In the Final Office Action, independent claims 1, 24, and 33 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,362,306 to McCarver in view of U.S. Patent No. 5,752,926 to Larson. Also, claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over the two above references in view of a U.S. Patent No. 5,804,021 to Abuto. Claims 20-21, 31 and 38 were also rejected as being unpatentable over the McCarver in view of Larson in further view of U.S. Patent No. 5,770,229 to Tanihara. Additionally, claims 22-23 were rejected under 35 U.S.C. § 103 as applied to claim 20 above, and in further view of U.S. Patent No. 5,120,758 to Satoh.

McCarver is directed to a surgical stockinette. The surgical stockinette is intended to encase an arm or a leg of a patient. For example, the stockinette is rolled into a ring before application to the arm or leg. To apply the stockinette, a closed end of the wrap is placed over the foot or hand of a patient and the remainder of the wrap is then unrolled by rolling the wrap down and over the limb. During a surgical procedure, an incision is made through the stockinette to expose the underlying skin where the surgery is to take place, while isolating the remainder of the arm or leg.

In stark contrast, independent claim 33 requires that the device of the present invention include a sleeve member made from a first panel attached to a second panel. As stated in claim 33, the panels form seams that extend along the length of the sleeve. In comparison, nowhere does McCarver disclose or suggest a hollow sleeve made from a first panel and a second panel as described above. As such, Applicants submit that even if the references are combined, absent any motivation, incentive, or suggestions to do so, the combination of the references does not disclose all of the limitations of independent claim 33.

The Examiner's attention is also directed to the subject matter of various dependent claims. For example, claims 20, 21, 22, 23, 31 and 38 are all directed to a device in which various additives have been applied to the sleeve member of the present invention. The additives can include, for instance, an antibiotic, an anti-microbial agent, a cationic polymer, an anti-inflammatory agent, and the like. In

comparison, nowhere does McCarver disclose or suggest treating the stockinette with any such additives.

As admitted in the Final Office Action, McCarver also fails to disclose that stockinette can have a shape configured to conform to the shape of a finger or toe of a user. In order to overcome the deficiencies of McCarver, the Office Action combined the teaching of Larson to state that it would have been obvious to one skilled in the art to configure the sleeve to conform to the shape of a finger or toe. Applicants respectfully disagree with this assertion and submit that the two references cannot be properly combined.

No motivation, incentive, or suggestion exists in either reference to combine the teachings of McCarver and Larson as suggested by the Office Action. As explained by the Federal Circuit, obviousness may only be established by modifying the teachings of the prior art to produce the claimed invention if there is some teaching, suggestion, or motivation to do so found either in the reference itself or in the knowledge generally available to one of ordinary skill in the art. See e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to modify the teachings of the references to arrive at the claimed invention. See e.g., *In re Regel*, 188 U.S.P.Q. 132 (C.C.P.A. 1975). Where no reasonable intrinsic or extrinsic justification exists for the proposed modification, a case of prima facie obviousness will not have been established.

Larson is directed to an orthopedic cast comprising an elastically deformed support which is held in its elastically deformed state by a solid casting composition. After the cast has been placed around the patient's limb, it is heated to soften the casting composition, permitting recovery of the cast into conforming contact with the limb. See Abstract. Once the cast is cooled again, it is rehardened to form the solid casting composition. Col. 6, ll. 32-35.

In this case, no motivation or suggestion exists to modify the teachings of McCarver with the solid cast disclosed by Larson. In fact, the Office Action ignores the entire disclosure of Larson that is directed to a solid casting composition for making a solid cast padded by a liner. One of ordinary skill in the art would not be motivated to modify the disclosure of a surgical stockinette of McCarver with the disclosure of a solid casting composition of Larson.

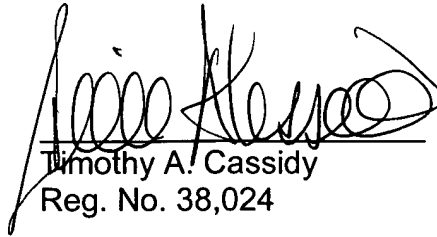
In fact, the combination of Larson and McCarver would destroy the function of the sleeve disclosed by McCarver because the solid casting composition of Larson would not allow easy incisions to be made into the cast. Thus, one of ordinary skill in the art would not be motivated to modify the surgical stockinette disclosed in McCarver in view of the teachings of Larson. Applicants submit that it is improper to simply pick and choose (or dismantle) just those components needed from a prior art reference to combine in a Section 103 combination.

Applicants emphasize that the teachings of the references must be viewed in their entirety, i.e., as a whole, to sustain a *prima facie* case of obviousness under 35 U.S.C. §103(a). Further, the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. That is, the differences between a particular claim and the cited references cannot be viewed in a vacuum. In this case, Applicants respectfully submit that, when properly viewed as a whole, there is simply no motivation to combine the references in the manner suggested in an attempt to render obvious the present claims.

In view of the above, Applicants submit that the claims as currently pending patentably define over McCarver either alone or in any combination with the other references cited in the Office Action. Favorable reconsideration and allowance of the present application are respectfully requested. Should any issues remain after consideration of this Response, however, then Examiner Hamilton is invited and encouraged to telephone the undersigned at her convenience.

Respectfully submitted,
DORITY & MANNING, P.A.

Date



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